IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT:	DANIEL M. BAEZA	
SERIAL NO.:	10/718,736	ART UNIT: 2629
FILED:	November 21, 2003	
FOR:	APPARATUS AND METHOD FOR CAPTURING SITE DATA WHILE SCUBA DIVING	EXAMINER: Sherman

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REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

In response to the Final Office Action mailed October 6, 2006 and the Advisory Action Mailed March 16, 2007, and in conjunction with the concurrently filed Notice of Appeal, Applicants request a pre-Appeal conference in view of the following remarks.

REMARKS

In response to the Office Action dated October 6, 2006, Applicant respectfully requests reconsideration based on the following remarks. Applicant respectfully submits that the claims as presented are in condition for allowance.

Claims 1 and 3-16 were rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the enablement requirement. The Examiner submits that there is insufficient explanation in the specification concerning the equalization device. In particular, the Examiner notes in the final Office Action that Applicant's prior response does not explain how the gap is equalized by the auto-equalizing device (see page 3 of the Office Action).

During a telephone interview with the Examiner, the undersigned and the Examiner discussed the auto-equalizing device. The Examiner seemed to believe that the auto-equalization device equalized pressure between top sheet 34 and glass base 38 so that the gap there between was maintained. Although this is a plausible interpretation of "auto-equalization," embodiments of the invention equalize electronically, rather than using internal pressure to compensate for ambient pressure. This results in a less complicated device. The specification, when read as a whole, clearly describes an electronic solution.

This description of the electronic equalization is found in paragraph [0021] which is reproduced below.

> In order to ensure that this does not happen and to ensure that the writing pad 20 can function in such an environment, and also to ensure that marks do not appear on writing pad 20 from the ambient water pressure applied to the writing pad 20, the gap 36 must be automatically equalized. The gap 36 is automatically equalized electronically by an auto-equalizing device 50. The auto-equalizing device 50 is implemented by hardware and/or software and works by comparing the voltage gradient against the pressure gradient reported by the pressure sensor 51, and an offset current relative to the depth is computed. The offset current is updated as the depth changes. Accordingly, writing is detected with reference to the offset current and the writing pad 20 is able to work underwater even as the water pressure varies (emphasis added).

As described in paragraph [0021], the pressure sensor is used to generate an offset current. The detection of writing on the pad is determined relative to the offset current. For example, if there is no water pressure on the writing pad, then the offset current is 0, and writing on the pad is detected by a signal from the writing pad with no offset. For ease of

illustration, assume that writing on the pad generates 1 volt when there is no additional pressure on the writing pad. As the device travels deeper underwater, the offset increases. For example, if water pressure generates an offset of 4 volts, then writing on the pad is detected for signals of 5 volts (offset voltage plus writing voltage). Accordingly, writing on the pad is determined with reference to the reference pressure from the pressure sensor. This ensures that the water pressure on the writing pad is not erroneously mistaken for writing. This is described in paragraph [0021] by at least "writing is detected with reference to the offset current" in conjunction with the other text in the application.

In the Advisory Action of March 21, 2007, the Examiner seems to maintain that the specification fails to disclose how the gap, a physical part of the device, is equalized. Applicant notes that the invention equalizes for pressure on the gap using electronic means. The Examiner appears to be requiring that the specification enable equalizing pressure in the gap by some mechanical or pneumatic means. While a phrase taken out of context from Applicant's specification may appear to require pressure equalization, it is clear that embodiments of the invention are directed to compensation for ambient pressure using electronic means. The originally filed specification does indeed enable one of ordinary skill in the art to make and use the invention, which includes electronic equalization of ambient pressure.

It is important to note the standard for enablement, reproduced below from MPEP § 2164.01.

> Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation.

In the present case, one of ordinary skill in the art would not need "undue experimentation" to make and use the invention. The notion of using an offset voltage to represent ambient water pressure, and measuring writing on the writing pad relative to the offset would not require undue experimentation. This concept of using offsets and measuring signals relative to offsets, although novel and non-obvious in the present application, permeates the field of electronics. Thus, no "undue experimentation" would be necessary to make and use the invention.

For the above reasons, claims 1 and 3-16 are enabled and the rejection should be withdrawn.

In view of the foregoing remarks and amendments, Applicants submit that the above-identified application is now in condition for allowance. Early notification to this effect is respectfully requested.

If there are any charges with respect to this response or otherwise, please charge them to Deposit Account 06-1130.

Respectfully submitted,

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